REMARKS

Claims 1, 3-9, 11-18, and 20-25 are pending in this application. Claim 25 has been added. Claims 12-15 have been amended merely to correct improper multiple dependent claims. Claim 6 has been amended to correct an antecedent error. Based upon the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1,3-9, 11, 13, 16-18, and 20-24 under 35 U.S.C. § 103(a) as being unpatentable over *Brooks* (USP 5,434,371) in view of *Sekendur* (USP 5,852,434); and rejected claims 12 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over *Brooks* in view of *Sekendur* and further in view of *Ullman* (WO 9946909). Applicant respectfully traverses these rejections.

Claim Rejections – 35 U.S.C. § 103

With regard to the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Brooks* in view of *Sekendur*, the Examiner admits that *Brooks* does not disclose that the registration device is detecting a position code arranged on a writing surface. The Examiner relies on the teachings of *Sekendur* to cure the deficiencies of the teachings of *Brooks* by asserting *Sekendur* teaches a position-related coding for indicating X-Y coordinates and a detector within the stylus, citing to col. 5, lines 1-21. Applicant respectfully disagrees with the Examiner's combination of these references.

It is respectfully submitted that the disclosure set forth in *Brooks* identifies a problem with conventional hand-held electronic writing instruments in that they record all movements, including writing movements and other movements, thus unnecessarily using

storage and power. *Brooks* seeks to solve this problem by providing for a writing instrument that starts recording only after an initializing character is recognized.

The writing instrument of *Brooks* is used in conjunction with a receiver at a computer capable of receiving digital information. The computer includes a translating package, which translates the digital information in order to determine the original markings made by the writing tip on the writing surface. The translated markings are displayed on the display and are a reproduction of the original markings (Abstract).

The writing instrument is any type of hand-held instrument, which marks a surface 3 such as paper, canvas, etc. (col. 3, lines 11-13). The writing implement includes a pressure sensor 10 on ball 7 at the tip 6 in order to sense when ball 7 is applied to and contacts the surface 3. An acceleration sensor 20 is also located at tip 6 for monitoring distance, time and changes in velocity for various directions or directional planes. (Col. 3, lines 22-33). As such, *Brooks* discloses a writing implement that is capable of determining the original markings made by the tip of the writing implement regardless of the type of surface 3.

In contrast, *Sekendur* discloses a position-coded surface and a pen for electronic recording of information written on the surface utilizing a position code. The writing instrument has an optical detector for detecting the position code, which can only be detected when it is in the field of view of the optical detector and at the appropriate distance therefrom. As such, one of ordinary skill in the art would not have been motivated to combine the teachings of *Brooks* and *Sekendur* as there would be no need to use an initializing character when using an optical sensor and a position-coded surface.

Further, one of ordinary skill in the art would not have been motivated to combine the teachings of *Brooks* and *Sekendur* as the *Brooks* writing instrument detects the markings regardless of the type of surface the markings are made on. Thus, one of ordinary skill would not look to utilize a position-coded surface in conjunction with the *Brooks* writing instrument because the *Brooks* writing instrument is self contained and does not need any positional information from the writing surface in order to discern the markings. As such, for at least these reasons, it is respectfully submitted that claim 1 is not obvious as one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner.

It is respectfully submitted that claim 1 recites, *inter alia*, a handheld electronic device which is adapted to carry out at least one operation, comprising a registration device for registering strokes when the device is moved; interpretation means for determining if the strokes comprise a command; wherein the registration device is adapted to record the command electronically by detecting a position code arranged on a writing surface, upon which the command is written. It is respectfully submitted that *Brooks* fails to teach detecting a position code arranged on a writing surface, upon which the command is written. Further, *Sekendur* fails to cure the deficiencies of the teaching of *Brooks*, assuming these references are combinable, which Applicant does not admit, as *Sekendur* fails to teach recording the command electronically by detecting a position code arranged on a writing surface, upon which the command is written. Thus, as neither of the references, either alone or in combination, teach or suggest all of the elements as set forth

in claim 1, claim 1 is not obvious over the references as cited. Thus, it is respectfully requested that the outstanding rejection be withdrawn.

Further, in support of the Examiner's rejection of claim 1, the Examiner recites as follows:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of a position-related coding and detector within the stylus as taught by Sekendur into the device system of Brooks because this would format the writing surface by writing by the code and reflect the selected frequency of light and detector picks-up the selected frequency of light.

It is respectfully submitted that in order to provide Applicant with a proper rejection under 35 U.S.C. § 103, the Examiner must include 1) the relevant teachings of the prior art relied upon; 2) the differences in the claim over the applied references; 3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and 4) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification (MPEP §706.02(j)). While the above statement, *arguendo*, provides the Applicant with the proposed modification, the Examiner has failed to provide the proper motivation for combining the references. Thus, the Examiner has failed to establish a *prima facie* case of obviousness by failing to provide proper motivation. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3-9 and 11-15 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 16 is allowable for the reasons set forth above with regard to claim 1 as claim 16 includes detecting a command, by electronically

detecting a position code. As noted above, neither *Brooks* nor *Sekendur* teach or suggest this feature. It is further respectfully submitted that claim 17 is allowable for the reasons set forth above with regard to claim 1 as claim 17 includes writing a command symbol to perform an operation on a surface that includes a position code and, as noted above, neither *Brooks* nor *Sekendur* teach or suggest this feature.

It is respectfully submitted that claims 18 and 25 are allowable for the reasons set forth above with regard to claim 1 as claim 18 contains elements similar to those discussed above with regard to claim 1.

It is respectfully submitted that claims 20-24 are allowable for the reasons set forth above with regard to claim 18 at least based upon their dependency on allowable claim 18.

Additional Comments

As noted above, claims 1, 3-9, 11-18, and 20-25 are pending in this application. In the Official Action dated June 4, 2003, the Examiner, *arguendo*, provided support for his rejection of claims 1 and 16-18. The Examiner failed to provide any support for his rejection of any of the dependent claims. As such, Applicant can not provide any response to these rejections. As noted above, the Examiner must provide, in support of the rejection of a claim under 35 U.S.C. §103, 1) the relevant teachings of the prior art relied upon; 2) the differences in the claim over the applied references; 3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and 4) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. Should the Examiner maintain his rejection

of the dependent claims, Applicant respectfully requests a detailed argument in support of the rejection in a non-final Official Action so that the Applicant may properly respond.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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